

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 27, 2005. Applicants respectfully request reconsideration and favorable action in this case in view of the following remarks.

Section 103(a) Rejections

The Office Action rejects Claims 1, 2, 5-10, 13-19 and 22-27 under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 6,116,741 issued to Paschal ("*Paschal*") in view of U.S. Patent No. 6,024,454 issued to Horan et al. ("*Horan*"). The Office Action also rejects Claims 3, 4, 11, 12, 20 and 21 are rejected under 35 U.S.C. § 103(a), as being unpatentable over *Paschal* in view of *Horan*, and in further view of U.S. Patent No. 3,528,720 issued to Treace ("*Treace*"). Applicants respectfully traverse these rejections for the reasons stated below.

Applicants submit that the Examiner has not provided the required evidence of a motivation to combine *Paschal* and *Horan* for reasons discussed in Applicants' previous response filed March 15, 2005. Applicants also respond to the Examiner's "Response to Arguments" on pages 2 and 3 of the Office Action as follows.

The Examiner argues that the *Paschal* – *Horan* combination would have been obvious to one of ordinary skill at the time of the invention because 1) one of ordinary skill in the art would generally recognize the desirability to protect a lens element; 2) it is well known that housings may be provided for protection of lens elements; and 3) a variety of housings for angled lens elements are known in the art. However, this reasoning does not address why a skilled artisan would be motivated to combine *Paschal* and *Horan*. Just because *Horan* teaches some kind of a housing 30 for an objective lens element 20, does not mean that the teachings of *Horan* can be combined with the teachings of *Paschal*. The Examiner offers no technical reasoning why one skilled in the art would be motivated to combine *Paschal* and *Horan*, or how a skilled artisan would be successful doing so.

In addition to the reasons discussed in the previous response filed March 15, 2005, Applicants also note that the objective lens cover 300 in *Paschal* is "housing" a lens cover 310. Thus, there is no need for a housing to combine with the objective lens cover 300. In fact, as described in the previous response, adding the housing of *Horan* would result in a

“substantial reconstruction and redesign of the elements shown in *Paschal*.” (See MPEP § 2143.01).

Thus, for the reasons discussed above and the reasons given in Applicants’ previous response filed March 15, 2005, a *prima facie* case of obviousness has not been established with respect to independent Claims 1, 6, 14 and 23. Reconsideration and favorable action are respectfully requested.

Dependent Claims 2-5 depend from independent Claim 1, dependent Claims 7-13 depend from independent Claim 6, dependent Claims 15-22 depend from independent Claim 14, and dependent Claims 24-27 depend from independent Claim 23. These dependent claims are also not rendered obvious by the *Paschal – Horan* combination proposed by the Examiner because they include the limitations of their respective base claim as well as additional limitations that further distinguish *Paschal* and *Horan*. Reconsideration and favorable action are respectfully requested.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fees are currently due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge said fees or credit any overpayments to Deposit Account No. **02-0384** of **BAKER BOTTS L.L.P.**

Respectfully submitted,

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